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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,613	08/16/2001	Ernst-Michael Hamann	DE920000049US1	3019

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11/01/2005

WILLIAM KINNAMAN, JR.
IBM Corporation, Intellectual Property
Law Department
2455 South Road, M/S P386
Poughkeepsie, NY 12601

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/931,613	Applicant(s) HAMANN ET AL.	
	Examiner Etienne P LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Status:

Claims 1-7 and 10-12 are pending. Claims 8 and 9 have been cancelled. Claims 1-7 and 10-12 are rejected as detailed below.

Specification Objection:

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Abstract Paragraph:

The present invention relates to electronic data carrier file systems, and in particular to file system management for small handheld data carriers, particularly for smart cards, i.e., chipcards having an own processor means. According to the present invention, static data objects are managed in a dynamic file system. A kind of embedment takes place in which one or more static objects are embedded in the dynamic file system within a file. The static objects are excluded from management actions performed on the dynamic file system. The static, embedded objects may have a fixed memory address inside the dynamic file system and cannot be moved to a different location by the dynamic file management functions. The static data objects can be accessed by easy command sequences without any complex file management functions, for example by boot routines in order to check personal security-relevant data.

The specification does not describe in clear and precise terms the manner and process of:

(1) creating management actions and (2) excluding the static object from such management actions and (3) making a kind of embedment in which one or more static objects are embedded in the dynamic file system.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 10 recite "embedding one or more static objects in the dynamic file system which are excluded from actions performed dynamically on the file system." The metes and bounds of the claim language is unclear because it is unclear during which operations, if indeed there are any actions at all, from which static objects are excluded. The specification clearly includes the following six situations wherein static objects are not (emphasis added) excluded from dynamic action(s).

Summary of Invention Paragraph:

[0016] By this approach the static data objects can be accessed by easy command sequences without any complex file management functions as was mentioned above, for example by boot routines.

Summary of Invention Paragraph:

[0017] On the other hand, the static data objects can also be accessed by the file management functions of the dynamic file system. No additional static files are necessary on the card to hold the static data objects.

Detail Description Paragraph:

[0051] It should be noted that the static objects in the combined file management system of the present invention can be accessed by the dynamic access functions in the normal way like other dynamic objects. Updates can be made with the limitation that the size of the object cannot be changed.

Detail Description Paragraph:

[0050] Further, the static objects can be deleted by the above-mentioned dynamic file access routines, including updating the directory information for the dynamic storage on the card.

Detail Description Paragraph:

[0051] It should be noted that the static objects in the combined file management system of the present invention can be accessed by the dynamic access functions in the normal way like other

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dynamic objects. Updates can be made with the limitation that the size of the object cannot be changed.

Detail Description Paragraph:

[0052] In addition the static objects can be accessed by primitive devices and applications using simple commands just indicating the start address and the offset. For example, a small handheld device reads information from the card by power-on of the card, selecting the dynamic file, and reading the data with a known size at a known address inside this file with a primitive read command.

Claims 2-7, 11 and 12 are rejected for being dependent from a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,220,510 issued to Everett et al (hereafter Everett), as best examiner is able to ascertain.

Claims 1 and 10-12:

Everett discloses embedding one or more static objects [Fig 1, 103] in the dynamic file system [Fig 1, 107] which are excluded from actions performed dynamically on the file system [col 5, lines 8-18, col 6, lines 15-20, col 8, lines 5-20, Fig 6, col 11, line 59 through col 12, line 30].

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Claim 2:

Everett discloses defining an embedded static object by a memory address and a fixed size [Figs 1 and 6]

Claim 3:

Everett discloses creating an embedded static data object by specifying a predetermined storage size, scanning memory for an available storage area large enough in size for receiving the static data object and allocating the storage area for the static object [Figs 1 and 6]

Claim 4:

Everett discloses creating an embedded object by specifying a storage area having a predetermined memory address and a predetermined storage size, allocating the storage area if it is not being used, and if the area is already in use, moving data using the area to a different memory location and allocating the area thereafter [Figs 1 and 6]

Claim 5:

Everett discloses managing a file system on a chipcard [col 2, lines 20-25]

Claim 6:

Everett discloses accessing a static object in a preboot phase of a host system connected to the chipcard [col 7, lines 30-35]

Claim 7:

Everett discloses storing security-relevant data in a static object [col 7, lines 30-35]

Response to Arguments

Applicant's arguments filed 9/17/2004 with respect to claims 1-7 and 10-12 have been considered but are moot in view of the new ground(s) of rejection. However, the following argument presented by applicant requires special attention.

Application Argues:

Applicant states in the second paragraph on page 5 "The examiner also wonders whether the static objects are permanently excluded from all operations. However, claim 1 does not say that the static object are excluded from all operations; it merely states that these objects are excluded from (at least some) operations performed dynamically on the file system."

Examiner Responds:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., at least some operations) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner maintains that applicant is confusing the claim language. The claim language does not even vaguely suggest "at least some operations."

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

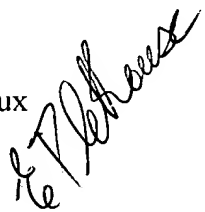
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

10/25/2005

A handwritten signature in black ink, appearing to read 'Etienne LeRoux', is written over the printed name and date.